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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,562	02/05/2004	Timothy Paddock	0978-0027	5513
26568	7590	07/08/2004	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,562

Applicant(s)

PADDOCK, TIMOTHY

Examiner

Christopher Bottorff

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on February 5, 2004 was considered by the examiner.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the raised portions of the deck that extend over the wheel axes, as defined in claim 3, and the front end of the deck that is similar to the rear end, as defined in claim 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

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per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3 defines the deck as extending over the wheel axes at one portion and below the plane defined by the wheel axes at another portion. However, the disclosure indicates that the deck is entirely suspended under the plane defined by the wheel axes. The disclosure does not explain how the suspended deck extends over the wheel axes.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-11 recite the limitation "the base" in lines 1, 1, and 2 respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kroher EP 0620031 B1.

Kroher discloses an all-terrain board comprising an elongate deck structure 1 and wheels 4 mounted at front and rear ends of the deck structure. See Figures 1 and 2. The deck structure comprises a central portion, which supports loops 14, disposed between the wheel axes and an upturned rear portion 2 disposed rearwardly of the rearmost wheel axis at the rear end of the deck structure. See Figures 1 and 2. The central portion of the deck structure extends below the level of a plane defined by the wheel axes and provides a front position for one of a rider's feet. See Figure 2. The upturned rear portion 2 of the deck structure extends rearwardly beyond the rearmost wheel 4 and provides a rear position for the rider's other foot. See Figures 1 and 2.

The wheels are mounted on respective axle assemblies 3 mounted to the upper surface of the deck structure, such that the deck structure extends under and is suspended below the wheel axes. Each wheel axle assembly 3 comprises an axle that is pivotally mounted relative to the deck structure. See Figure 1. A base 8 of the rear axle assembly is elongate and extends axially of the deck structure between the central and upturned rear portions of the deck structure. See Figure 3. A member 10 that limits the angle through which the axle can pivot relative to the board connects each end of the axle to the deck structure. See Figure 2. Also, the front end 2 of the deck structure has a similar structure to the rear end 2 of the deck structure. See Figures 1 and 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0620031 B1 in view of Barachet US 5,160,155.

Kroher does not disclose that the upturned rear end extends to a point substantially in-line with or above the plane defined by the wheel axes. However, Barachet teaches that extending an upturned rear end 18 of a sports board to a point substantially above a plane defined by the wheel axes 3 and 8 was desirable. See

Figure 1. From the teachings of Barachet, extending the upturned end of Kroher to a point substantially above the plane defined by the wheel axes would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enhance the leverage provided by the upturned rear end.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0620031 B1 in view of Cole and Bondurant US 1,123,686.

Kroher does not disclose that each axle is pivotable against a resilient bias. However, Cole and Bondurant teach the desirability of providing a resilient bias *i* on a pivotable axle of a sports board. See Figures 1 and 3 and page 1, lines 65-68. From the teachings of Cole and Bondurant, providing the axles of Kroher with a resilient bias against which to pivot would have been obvious to one of ordinary skill in the art at the time the invention was made. This would help maintain the axles in their normal positions.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0620031 B1 in view of Runyan, Jr. US 4,029,330.

Kroher does not disclose that the base of the rear axle assembly or an elongate strengthening member is fitted to the deck structure at a point where the upturned end commences. However, Runyan, Jr. teaches that fitting an elongate strengthening member 22 to a deck structure at a point where an upturned end commences, and arranging a base 13 of the rear axle assembly along the strengthening member 22 at a

point where an upturned end commences, was desirable. See Figures 2-4; column 3, lines 44-49; and column 4, lines 20-28. From the teachings of Runyan, Jr., fitting the base of the rear axle assembly or an elongate strengthening member of Kroher to the deck structure at a point where the upturned end commences would have been obvious to one of ordinary skill in the art at the time the invention was made. This would reinforce the deck structure where it is angled and would allow the axles to be positioned as desired for a particular use, such as slalom.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heilig US Des. 302,993 in view of Peterson US 3,767,220.

Heilig discloses an all-terrain board comprising an elongate deck structure and wheels mounted at front and rear ends of the deck structure. The deck structure comprises a central portion disposed between the wheel axes and an upturned rear portion disposed rearwardly of the rearmost wheel axis at the rear end of the deck structure. See Figure 3. The upturned rear portion of the deck structure extends rearwardly beyond the rearmost wheel and provides a rear position for the rider's other foot. See Figures 3 and 4. The central portion of the deck structure appears to extend below the level of a plane defined by the wheel axes and provides a front position for one of a rider's feet. See Figure 4.

The upturned rear end of the board extends upwardly and rearwardly to a point substantially in-line with or above the plane defined by the wheel axes. See Figure 4. The deck structure comprises raised portions that respectively extend over the wheel

axes and a lowered central portion that appears to extend below the plane defined by the wheel axes. See Figure 4.

Although the central portion appears to extend below the level of a plane defined by the wheel axes, this is not clearly disclosed. However, Peterson teaches that extending a central portion 14 of a deck structure below the level of a plane defined by the wheel axes is beneficial to the stability of the vehicle. See Figure 1; column 1, lines 23-25; and column 2, lines 32-44. From the teachings of Peterson, extending the central portion of Heilig below the level of a plane defined by the wheel axes would have been obvious to one of ordinary skill in the art at the time the invention was made. This would enhance the stability of the board.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 8 defines the resilient bias as being provided by an elastomeric member. This feature, in combination with the further limitations of the claim, is not taught by the prior art.

Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 12 defines the pivot limiting member as comprising a rigid strut having a coupling at an end. This feature, in combination with the further limitations of the claim, is not taught by the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenblum, Thomas, Schmid, Osawa, Lehman, Flynn, Lee, Dornan US 6,254,113, Chang et al., Attey, Dornan US 6,568,695, and Todd disclose sports board arrangements.

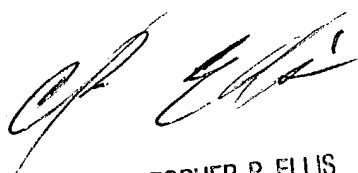
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 305-0168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher Bottorff



CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1100